UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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AND INTERFERENCES

Ex parte MANJIT S. CHOWDHARY, and WALTER M. WHITE

Appeal No. 2004-2017
Application 09/501,559

ON BRIEF

Before OWENS, WALTZ, and JEFFREY T. SMITH, *Administrative Patent Judges*, WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1-11, 27-32, 34-39 and 41-70. Claims 12-26, 33 and 40, the remaining claims in this application, stand withdrawn from further consideration as being directed to a non-elected invention (final Office action dated Mar. 28, 2003). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a process for improving the hydration characteristics of guar gum powder by including the step of extruding guar gum splits prior to grinding same (Brief, page 2). Appellants state that the rejected claims stand or fall together (Brief, page 4). Therefore, in accordance with the provisions of 37 CFR § 1.192(c)(7)(2000), we select one claim from each ground of rejection (i.e., claims 1 and 3) and decide the grounds of rejection in this appeal on the basis of these claims alone. *See also In re McDaniel,* 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 1 is reproduced below:

> 1. A method of manufacturing a powder having improved hydration characteristics, the method comprising the steps of:
>
> (a) hydrating guar gum splits;
>
> (b) processing the hydrated splits, said processing step including the substeps, in either order, of flaking the splits and extruding the splits;
>
> (c) grinding said processed splits into a powder; and
>
> (d) drying the powder.

In addition to the admitted prior art found in appellants' specification, the examiner relies upon the following references as evidence of obviousness:

Rutenberg et al. (Rutenberg)	4,269,975	May 26, 1981
Dino	5,646,093	Jul. 08, 1997
Harris	5,990,052	Nov. 23, 1999

Claims 1, 2, 5-11, 27-30, 34-37, 41-66, 69 and 70 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Rutenberg (Answer, page 3). Claims 1, 3, 4, 27, 31, 32, 34, 38, 39, and 66-68 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Rutenberg in view of Dino, Harris and the admitted prior art as found in appellants' specification (Answer, page 5). We *affirm* both rejections on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

The examiner finds that Rutenberg discloses a method of manufacturing guar gum powder and teaches that extruding the hydrated guar gum splits prior to grinding results in a gum with increased viscosity (Answer, page 3). The examiner also finds that Rutenberg teaches flaking (flattening) of the hydrated guar gum splits prior to grinding results in a product with higher viscosity than non-flaked guar gum splits (*id.*). The examiner recognizes that Rutenberg fails to disclose the use of *both* extruding and flaking steps as required by claim 1 on appeal, but concludes that it would have been obvious to one of ordinary skill in this art to combine such steps since "it would logically flow that the combination would produce the same effect, and would supplement each other." Answer, page 4, citing *In re Crockett,* 279 F.2d 274, 126 USPQ 186 (CCPA 1960). We agree.

Appellants argue that Rutenberg "teaches away" from both extruding and flaking by downplaying the effectiveness of the flaking step (Brief, pages 5-7). This argument is not well taken. As held by our reviewing court:

> Although a reference that teaches away is a significant factor to be considered in determining unobviousness, the nature of the teaching is highly relevant, and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use. *In re Gurley,* 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

On this record, it is undisputed that Rutenberg teaches that although "the use of flattening (flaker) rolls gives a gum with higher viscosity-producing properties than gum prepared without the flattening rolls, the use of an extruder under the same operational conditions gives gums with much higher viscosity-producing properties." Col. 7, ll. 15-20. Accordingly, we determine that Rutenberg merely teaches somewhat inferior results for the process when using a flaking step as compared to extrusion, although also teaching that flaking produces better results than no flaking step. See Rutenberg, col. 1, ll. 40-53; col. 5, ll. 4-13; col. 5, l. 65-col. 6, l. 2; and col. 7, ll. 1-14. Therefore we determine that Rutenberg does not teach away from the claimed subject matter.

Appellants argue that *In re Crockett* is distinguishable since the facts in that case are not sufficiently similar to those here (Brief, page 10). Appellants argue that in *Crockett* distinct references effectively taught that two different processes would each produce the same result so that these processes could be logically combined while here Rutenberg alone teaches that two different processes each produce very different results, with extruding producing a result far superior to flaking (*id.*). Appellants thus submit that one of ordinary skill in the art would have had no logical motivation to combine flaking with extruding (*id.*).

These arguments are not persuasive. We find no language or holding in *Crockett* which limits the obvious combination of steps to those which would each produce the *same* result. Accordingly, we determine that *Crockett* is applicable to the facts of this appeal where each step produces the same *type* of result, although one result is superior to the other. As stated in *In re Crockett,* 279 F.2d 274, 276, 126 USPQ 186, 188 (CCPA 1960):

> We agree with the Patent Office tribunals that the combination of steps of claim 94 would have been obvious to a person of ordinary skill in the art. The patents clearly teach that both magnesium oxide and calcium carbide, individually, promote the formation of a nodular structure in cast iron, and it would be natural to suppose that, in combination, they would produce the same effect and would supplement each other.

On this record, Rutenberg clearly teaches that both flaking and extruding, individually, promote higher viscosity-producing properties (i.e., lead to a product which disperses and hydrates more rapidly in water; see col. 3, ll. 48-53). Therefore it would be natural to suppose that, in combination, these steps would produce the same effect and would supplement each other. The idea of combining these steps would flow logically from the teaching of the prior art. *See In re Crockett, supra;* and the Answer, page 7.

Appellants argue, with respect to the second rejection on appeal, that the examiner has failed to articulate a suggestion to combine Rutenberg with Dino, Harris, and appellants' specification (Brief, page 11). This argument is not persuasive since the examiner has clearly set forth the motivation or suggestion to combine these references as noted in the Answer, pages 5-6 and 8-9. Appellants do not present any

arguments concerning the specific reasons set forth by the examiner to support the combination of references, nor do appellants challenge the examiner's citation of admitted prior art from their specification.

Appellants argue that the examiner has not shown the hydration rate properties at specific temperatures as recited in claims 41-70 (Brief, page 14). This argument is not well taken since, as noted above, Rutenberg teaches that extruding the hydrated guar gum splits will result in a product which disperses and hydrates more rapidly (col. 3, ll. 48-53). The specific rates of hydration at various temperatures clearly would be well within the skill of the art, depending on the extruder conditions as well as other parameters (e.g., see Rutenberg, col. 3, ll. 26-41). The law is replete with cases in which the difference between the claimed subject matter and the prior art is some range or other variable within the claims. These cases have consistently held that, in such a situation, appellants must show that the particular variable is critical. *See In re Woodruff,* 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Appellants have not offered any evidence of criticality on this record.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness based on the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore, we affirm both rejections on appeal.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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